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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/303,232	04/30/1999	MARTIN ADAMCZEWSKI	MO-5176/LEA3	8055

7590 10/21/2003

BAYER CORPORATION  
PATENT DEPARTMENT  
100 BAYER ROAD  
PITTSBURGH, PA 15205

EXAMINER
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SCHNIZER, RICHARD A

ART UNIT	PAPER NUMBER
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1635

35

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/303,232

Applicant(s)

ADAMCZEWSKI ET AL.

Examiner

Richard Schnizer, Ph. D

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 2-7, 10, 24-31 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 2-7, 10, 24-31 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

An amendment was received and entered as Paper No. 34 on 7/30/03.

Claims 2-7, 10, 24-31, and 35 are pending and under consideration in this Office Action.

This Action is NON-FINAL due to new grounds of rejection.

### ***Rejections Withdrawn***

The rejections under 35 USC 112 first paragraph are withdrawn in view of Applicant's amendments.

### ***Drawings***

The drawings are objected to for the reasons of record in Paper No. 8.

### ***Compliance with Sequence Rules***

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the following reason(s). This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rule making notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63

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FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998). **Nucl otide sequences in excess of 10 nucleotides are disclosed at page 10, lines 3 and 4, page 13, lines 10, 1, 23, and 24, and page 14, lines 15 and 16, but these sequences have not been accorded a SEQ ID Number.**

Applicant must provide:

A substitute computer readable form (CRF) copy of the "Sequence Listing".

A substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.

A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

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### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-7, 10, 24-31 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-7, 10, 24-31 and 35 are indefinite because it is unclear what is intended by the phrase "a sequence according to" in part (a) of independent claim 35. It is unclear if this phrase requires that the sequence in question must be identical to the sequences that follow, or whether the entirety of the sequences that follow are required in order to meet the conditions of the claim. For example, it is unclear if a fragment of SEQ ID NO:1 from base 400-410 would anticipate the claim.

This rejection can be overcome by substituting "comprising" for the phrase "according to".

Claims 24 and 25 are indefinite because it is unclear to which vector of claims 2 or 3, respectively, these claims refer. Substitution of "the vector" for "a vector" is suggested. Use of a definite article would make it clear that claims 24 and 25 embrace all of the vectors of the claims from which they depend.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 35 is rejected under 35 U.S.C. 102(b) as being anticipated by anyone of Celniker (1998), Liao (1998), or Vogel (1998) (all of record).

Celniker teaches GenBank Accession No. AC004326 which comprises a segment that is identical to bases 496-836 of SEQ ID NO:1.

Liao teaches GenBank Accession No. AF045432 which comprises a segment that is identical to 79 bases of SEQ ID NO:3.

Vogel teaches GenBank Accession No. Z97178 which comprises a segment that is identical to 98 bases of SEQ ID NO:5.

Because each of these nucleic acids is double stranded, each comprises a segment that is complementary to SEQ ID NO:1, 3, or 5, as required by part (b) of claim 35. This rejection can be overcome by amending part (b) to require that the claimed nucleic acid must be complementary to the entire length of the nucleic acids recited in part (a).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 2-7 and 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Celniker (1998), Liao (1998), or Vogel (1998) taken in view of Ausubel (of record).

Celniker, Liao, and Vogel teach nucleic acids comprising segments complementary to SEQ ID NOS: 1, 3, or 5, respectively. These references do not teach expression vectors or host cells comprising the nucleic acids.

Ausubel teaches prokaryotic and eukaryotic expression vectors, and methods of transferring these vectors into hosts for the production of the encoded polypeptides.

It would have been obvious to one of ordinary skill in the art at the time of the invention to place the nucleic acids of Celniker, Liao, and Vogel into expression vectors and to transform host cells for the production of the encoded proteins. One would have been motivated to do so in order to biochemically characterize the proteins.

Thus the invention as a whole was prima facie obvious.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Richard Schnizer, whose telephone number is 703-306-5441. The examiner can normally be reached Monday through Friday between the hours of 6:20 AM and 3:50 PM. The examiner is off on alternate Fridays, but is sometimes in the office anyway.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached at 703-306-3217. The official central fax number is 703-872-9306. Inquiries of a general nature or relating to the status of the application should be directed to the Patent Analyst Trina Turner whose telephone number is 703-305-3413.

Richard Schnizer, Ph.D.



DAVE T. NGUYEN  
PRIMARY EXAMINER